

Linehan, the issuing bank may deal directly with the merchant whereas the cited art discloses the payment computer or issuing bank dealing only with the consumer. Linehan also discloses generating a reference number for the consumer's credit card number thereby hiding the credit card number from network "snoopers" and others. There is no disclosure of a reference number in any of the cited references. Linehan also discloses the issuing bank generating and transmitting to the merchant an authorization token and the reference number which authorize payment to the merchant. The cited art discloses the payment computer generates and send via the consumer an access URL authorizing the merchant to send a fulfillment order to the consumer which not a payment authorization to the merchant, as in the case of Linehan. The Examiners indicated that the claims appear to be allowable. The interview is summarized in the Interview Summary, dated May 18, 2001

In the response to the Office Action of September 9, 2000 Applicants filed this CPA and amended independent Claims 1, 26, 27, 28, 33, 34, 46, 49 to further distinguish over the cited art taken alone, or in any combination.

Specifically, the rejected independent Claims were amended to include "a reference number" as shown in Figure 2B and described in the specification at page 9, lines 16-24. The reference number accompanies an authorization token and is created by the issuing bank as a means of disguising a consumer's credit number during the flow of a transaction. The Examiner alleges the addition of an issuing bank creating a reference number has been taught by Payne in Column 6, lines 31-42 and shown in step 62. The reading of the cited text does not support the Examiner's conclusion in the following respects:

(a) The payment computer is not an issuing bank that stores consumer credit card numbers and matching reference number. The payment computer manages the transactions between the buyer computer and the merchant computer.

(b) The payment computer instructs the buyer to provide account name and password which information is provided by the user. There is no matching of credit card numbers and reference number by the payment computer to hide the identity of the consumer's credit card.

(c) There is no combining of the reference number and authorization token as a basis for a merchant to fulfill the order of a consumer.

Without a teaching of a reference number and accompanying authorization token in Payne or in Elgamal, Gifford, Anderson, or O'Mahoney, there is no basis for a worker skilled in the art to implement the invention as defined in Claim 1. Withdrawal of the rejection of Claim 1 under 35 USC 103(a) is requested.

Likewise, Claims 26, 27, 28, 33, 34, 46, and 49 all include the limitation relating to the generation of the reference number and the accompanying authorization token to complete a transaction and are believed to be patentable on the same basis as Claim 1. Withdrawal of the rejection of these claims under 35 USC 103(a) is requested.

Claims 26, 33, 34, and 46 further define a capture request message described in the specification at page 10, lines 1-12. The Examiner alleges that a capture request message is described in Payne at Column 6, lines 16-59. Applicant submits that Payne fails to disclose a capture request message for the following reasons:

(a) The capture request message includes the reference number which applicant has pointed out is not disclosed in Payne for the reasons indicated in the response to the Claim 1 rejection.

(b) The buyer computer creates an account document which includes a credit card number, credit card expiration, and security information which is sent to the payment computer for entering into the settlement database. In contrast, applicant claims the merchant sends the capture request, not the buyer, for disbursement of payment to the merchant. Payne does not disclose disbursing payment to the merchant.

(c) A capture request message is sent to the acquiring bank by the merchant, whereas Payne discloses the buyer sending account information to the payment computer (corresponding to the Linehan's issuing bank) which is not an acquirer bank .

Accordingly, without a disclosure in Payne or in Elgamal, Gifford, Anderson, or O'Mahoney of a merchant computer sending a capture request including a reference number to an acquiring bank for settlement of a transaction, there is no teaching in Payne for a worker skilled in the art to implement the four-party payment protocol system and method described in independent Claims 26, 33, 34, and 46. Withdrawal of the rejection of these claims under 35 USC 103(a) is requested.

Independent Claims 27, 33, 34, and 49 further recite the acquiring bank settling accounts with the issuing bank over a private network by sending a settlement message that includes the reference number to the consumer's card number. The Examiner alleges that Elgamal at Column 11, line 43 through Column 12, line 63, discloses the claimed step of settling the account with the issuing bank. Applicant submits that Elgamal fails to support settling an account with the issuing bank for the following reasons:

(a) Elgamal does not disclose a reference number in the settlement process described in the cited text.

(b) There is no disclosure in Elgamal of an acquiring bank settling accounts with an issuing bank. The cited text discloses settlement occurring between the merchant and the gateway and not between an acquiring bank and an issuing bank.

(c) Applicant submits that without a disclosure of a reference number in Elgamal or Payne and settlement between an issuing bank and acquiring bank, there is no teaching for a worker skilled in the art to implement the settlement feature described in independent Claims 27, 33, 34, and 49. Withdrawal of the rejection of these claims under 35 USC 103(a) based upon Elgamal or Payne in view of Elgamal, lacking support for the claimed feature in the cited art.

Dependent Claim 15 has been rejected as unpatentable over Payne, Elgamal, Gifford, Anderson, O'Mahoney and, in further view of Ogram. Claim 15 depends upon Claim 1 and describes the issuing gateway sending an authorization token directly to the merchant. Claim 15 is patentable on the same basis as Claim 1. None of the references disclose an issuing bank creating a reference number which accompanies an authorization token sent to a merchant computer for fulfilling a consumer's order.

Without a teaching of a reference number in the cited references, there is no basis for a worker skilled in the art to implement Claim 15. Accordingly, withdrawal of the rejection of Claim 15 under 35 USC 103(a) based upon the cited references is requested.

Claims 51-54 which depend upon Claim 1 were rejected under 35 USC 103(a) as unpatentable over Payne, Elgamal, Gifford, Anderson, and O'Mahoney. Claims 51-54 are patentable over the cited references for the following reasons:

(a) None of the references describe an issuing bank generating a reference number which accompanies an authorization code used by a merchant in fulfilling a consumer's order. Accordingly, Claims 51-54 are patentable on the same basis as Claim 1.

(b) Claim 51 further recites sending a capture request message including a reference number from the merchant to an acquiring bank. Applicant has previously pointed out the absence of the claimed capture request message in distinguishing Claims 26, 33, 34, and 46 from the cited prior art.

(d) Claim 52 further recites settling the accounts with the issuing bank by the inquiring bank by sending a settlement message that includes a reference number. None of the cited art discloses sending a settlement message including a reference number in a transaction between an issuing bank and an acquiring bank as previously pointed out by applicant in distinguishing Claims 27, 33, 34, and 49 from the cited art.

Claim 53 further defines the details of converting the reference number into a consumer's card number and applying the transaction amount to the consumer's balance in the credit card or debit account. The Examiner cites Payne and Elgamal for settling accounts, but the details described in the cited art provide no support for the rejection of Claim 53. First, the references do not disclose a reference number generated by an issuing bank, nor do the references describe converting the reference number to a credit card number for applying the transaction amount to the consumer's balance in his credit card or debit card account.

Without such teachings in the cited references, there is no basis for a worker skilled in the art to implement the feature described in Claim 1. Withdrawal of the rejection of Claim 53 under 35 USC 103(a) is requested.

Claim 54 further amends Claim 1 to include proving the issuing bank authorized the payment to the merchant. Neither Payne, nor Elgamal, describe the merchant proving the issuer authorized the payment for a transaction using the combination of the issuer's signature on the

authorization token, an issuer's digital certificate in the contents of an authorization token as described in the specification at page 10, lines 14-19.

Without a teaching of a merchant proving authorization for a transaction in the cited references, there is no basis for a worker skilled in the art to implement the feature described in Claim 54.

Withdrawal of the rejection of Claim 54 under 35 USC 103(a) is requested.

CONCLUSION:

Applicant submits that the cited art fails to describe or enable a worker skilled in the art to implement Claims 1 - 56 as follows: (a) Payne is a three party payment protocol, not a four party protocol ; (b) The conversion of Payne to a four party protocol using the secondary references is beyond the skill of worker in the art as requiring undue experimentation and effort; (c) Payne and the secondary references do not describe or teach a reference number; (d) the combination of an authorization token and a reference number for payment to a merchant is not described or taught; (e) a capture request from a merchant to an acquiring bank for disbursement for payment to the merchant is not described or taught; (f) a settlement message between the issuing bank and acquiring bank that includes a reference number to the consumer's credit card number is not described or taught, converting the reference number into a credit card number, and applying a transaction amount to the consumer's balance in the credit card defined by the reference number is not described or taught; (g) proving a merchant is authorized payment by an issuing bank based upon an authorization token, digital certificate and issuing bank's signature is not described or taught; and (h) combining the 3 party protocol of Payne with non e-commerce art does provide a basis for a worker skilled in the art to implement the 4 party e-commerce invention described in Claims 1-56 . Without these features in the cited art, applicant submits

there is no basis for a rejection of Claims 1-54 under 35 USC 103(a) as lacking sufficient teaching for a worker skilled in the art to implement the claimed invention. Withdrawal of the rejection of Claims 1-54 is requested.

AUTHORIZATION:

The Commissioner is hereby authorized to charge any additional fees which may be required for the timely consideration of this amendment under 37 CFR §§ 1.16 and 1.17, or credit any overpayment to Deposit Account No. 09-0459, Order No. SE9-98-031/1963-7291.

Respectfully submitted,

MORGAN & FINNEGAN, L.L.P.

Dated: May 21, 2001

By: Joseph C. Redmond, Jr.
Joseph C. Redmond, Jr.
Registration No. 18,753
202-857-7887 – Telephone
202-857-7929 – Facsimile

CORRESPONDENCE ADDRESS:

Morgan & Finnegan, L.L.P.
345 Park Avenue
New York, NY 10154-0053